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Shinichi Takagi

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EXAMINER

CLARK, SHEILA V

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/987,153
Filing Date: November 13, 2001
Appellant(s): TAKAGI ET AL.

James A. Labarre
Buchanan Ingersoll and Rooney
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 10, 2008 appealing from the
Office action mailed April 7, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 11-47, 51-54, 56-62 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

All independent reissue claims 11, 16, 21,22, 24, 25, 27, 28, 30, 33, 35, 36, 38, 40, 42, 45, 51, 52, 54, 55, 59, 60, 61 contain recapture issues whereby said claims fail to contain subject matter surrendered in the original application. Claim language similar to “wherein said level difference serves to avoid capillary flow of solder to prevent short-circuiting between the leads adjacent to each other” appears in every patented independent claim. Applicant in the amendment filed 6-15-1999 presented arguments

relative to the level difference allowing a clearance so to avoid the capillary flow of solder which caused short circuiting as an essential feature regarding the patentability of this invention and whereby this feature was therefore added to obtain allowance of the original patent. This feature appears relates to subject matter previously surrendered in the original application and must be included in the reissue claims.

The MPEP 1412.02 states that, "for example, assume that limitation A of the patent claims is omitted in the reissue claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. If the omitted limitation A was argued in the original application to make the application claims allowable over the art in the application, then the omitted limitation relates to subject matter previously surrendered in the original application" see 142 F.3d at 1482,46 USPQ2d at 1649.

(10) Response to Argument

The primary issue relative the instant claims on appeal is centered upon "recapture" as stated applicant's ground of rejection section that states that the claims stand finally rejected under 35 U.S.C. 251 on the grounds that they are considered to be "an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based." Applicant has centered his arguments around the case of *Exparte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) whereby applicant asserts that said decision renders "subject matter that was surrendered by a patentee is measured with reference to the rejected claim

that existed prior to amendment, rather than the amended claim that issued in the patent”.

Contrary to applicant's arguments current reissue practice relative to recapture outlined in the MPEP 1412.02 looks to the Three Step Test For Recapture to determine recapture (the decision of *In Clement*, 131 F.3d at 1468-70, 45 USPQ2d at 1164-65, the Court of Appeals for the Federal Circuit set forth a three step test for recapture analysis. *In North American Container*, 415 F.3d at 1349, 75 USPQ2d at 1556).

The MPEP details the application of the recapture rule as a three-step process having the steps of (1) first, determining whether, and in what respect, the reissue claims are broader in scope than the original patent claims: (2) next, determining whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and (3) finally, determining whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.

With regard to the first step, the instant claims fail to contain particular claimed subject matter recited in the patented claims and thereby establishing “broadening claims”. In the second step the broadening aspects were found to relate to subject matter previously surrendered during the prosecution of the original application. The limitation A example the MPEP cites will be utilized here, whereby after review of the file original file history it was found that limitation A (“wherein said level difference serves to avoid capillary flow of solder to prevent short-circuiting between the leads adjacent to each other”) of the patent claims was omitted in the reissue claims. This omission

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provides a broadening aspect in the reissue claims, as compared to the claims of the patent. The MPEP continues further to state that if the omitted limitation A (“wherein said level difference serves to avoid capillary flow of solder to prevent short-circuiting between the leads adjacent to each other”) was argued in the original application (the amendment filed June 15, 1999-see attachment) as a feature that made the originally filed claims allowable over the art in the application, then the omitted limitation relates to subject matter previously surrendered in the original application and recapture will exist. The MPEP further states that if the broadening in the reissue application relates to subject matter that was surrendered during the examination of the patent is the subject of the reissue application because such subject matter was argued to overcome a rejection as discussed supra. If surrendered subject matter has been entirely eliminated from a claim as it is in the instant reissue application, or has been in any way broadened in a reissue application claim, then a recapture rejection under 35 U.S.C. 251 is proper and must be made for that claim.

With regard to the last step and determining whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule. Applicant attempts to argue comparisons relative to claim language presented in the claims of the original patent and the language of the instant claims to establish that he is not attempting the recapture surrendered features but is presenting narrowing structure. The recited features appear to be an attempt to use different words to recite the same features recited in the patented claims and thereby presenting features that are not narrower in scope. For example applicants

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example "bent in an outward direction relative to the side surface of said package", and that this open end portion is "downwardly protruded from a plane including a bottom surface of said package" recited in claim 11 of the instant claims appears to say the same thing as "leads extending along said side surfaces of the package and extending to a package attaching plane" wherein if leads extending down the side they may be bent then the attaching place would be the bottom surface of the package.

Further applicant's argument relative to the one recitation (that is subject of the recapture issue discussed supra) that appears in original claim 1 where he states "wherein said level difference serves to prevent the short-circuiting between the leads adjacent to each other." That he asserts is not present in reissue claim 11 and further asserts, does not define a structural feature that limits the scope of the claim, presents only piecemeal portions of the line and omits recited features such as "capillary flow of solder" which indeed defines structural intention that has direct bearing on the scope of the invention. Further these features were argued in the amendment of June 15, 1999 as being critical to make the original claims allowable over the art in the application and thereby according to the MPEP recapture will exist.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejection should be sustained.

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Respectfully submitted,

/S. V. Clark/

Primary Examiner, Art Unit 2823

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June 4, 2009